

REMARKS

This Application has been carefully reviewed in light of the Final Office Action mailed April 11, 2007. At the time of the Final Office Action, Claims 1-24 and 26-52 were pending in this Application. Claims 12 and 51 have been amended to further define aspects of the present invention. Claims 1-11, 13-21 and 27-50 were previously withdrawn due to an election/restriction requirement. Claims 12, 22-24, 26, 51 and 52 were rejected. Claim 25 was previously cancelled without prejudice or disclaimer. Applicants respectfully request reconsideration and favorable action in light of the comments below.

Objections to Drawings

The drawings filed September 25, 2006, were objected to by the Examiner because the sheets were not properly labeled with "Replacement Sheet". Applicants enclose herewith 28 sheets of new corrected drawings in compliance with 37 CFR §1.121(d) and submit that no new matter has been added.

Rejections under 35 U.S.C. §103

Claims 12, 22, 23, 51 and 52.

Claims 12, 22, 23, 51 and 52 stand rejected under 35 U.S.C. §103(a) as being anticipated over U.S. Patent No. 5,507,743 issued to Edwards et al. ("Edwards") in view of U.S. Patent No. 5,873,877 issued to McGaffigan et al. ("McGaffigan"). Applicants respectfully traverse and submit that the cited art does not render the claimed embodiments of the invention obvious.

In order to establish a prima facie case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Independent Claim 12 recites the step of: "c) applying a high frequency voltage to the electrically conductive fluid between the active electrode and the return electrode sufficient to vaporize the electrically conductive fluid, wherein at least a portion of the tissue at the target site is ablated by the vaporized electrically conductive fluid."

Independent Claim 51 recites the step of: “applying a high frequency voltage to an electrically conductive fluid between the active electrode and the return electrode sufficient to vaporize the electrically conductive fluid such that at least a portion of the tissue at the target site is modified by the vaporized electrically conductive fluid.”

Applicants submit that both Edwards and McGaffigan both disclose electrosurgical apparatus in which the electrode is designed to be inserted into the targeted tissue, thus delivering electrical energy directly into such tissue. See Edwards, col. 5, lines 4-14 and McGaffigan col. 8, lines 30-42. Accordingly, Edwards and McGaffigan considered separately or in combination fail to disclose delivering a high frequency voltage through an electrically conductive fluid in order to vaporize the electrically conductive fluid such that the vaporized electrically conductive fluid is used to ablate tissue. Instead, Edwards and McGaffigan are limited to traditional bipolar electrosurgical applications in which the electrodes are designed pass current directly through the target tissue to heat, ablate or otherwise treat the target tissue.

Applicants respectfully request reconsideration, withdrawal of the rejections under §103 and full allowance of Claims 12 and 51 and Claims 22, 23 and 52 that depend therefrom.

Claims 24 and 26.

Claim 24 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Edwards and McGaffigan in view of U.S. Patent No. 5,715,817 issued to Stevens-Wright et al. (“Stevens-Wright”). Claim 26 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Edwards, McGaffigan and Stevens-Wright and further in view of U.S. Patent No. 5,348,554 issued to Imran et al. (“Imran”).

Applicants traverse. Based on the remarks set forth above Applicants submit that Claims 24 and 26 depend from Claims that are in condition for allowance. Additionally, for corresponding reasons, the additional citation of Stevens-Wright and Imran also fail to render obvious Claims 24 and 26. See Stevens-Wright, Col. 6, lines 31-46, describing use of a single thermistor element 52 to effect ablation and provision of ring electrodes 48 to provide “signal information on heart potentials to remote recording equipment (not shown) used by the electrocardiologist.” And see Imran, Col. 4, lines 38-42, discussing introduction of RF energy

“into the wall forming a chamber of the heart to cause ablation”. Applicants respectfully request reconsideration, withdrawal of the rejections under §103 and full allowance of Claims 24 and 26.

Double Patenting Rejection

The Examiner provisionally rejected Claims 12, 22-24, 26, 51 and 52 based on the judicially created double patenting doctrine over the pending claims of co-pending Application 10/072,599 by Dahla et al. (“’599 application”) stating that the subject matter claimed in the instant application is fully disclosed in the referenced co-pending application and would be covered by any patent granted on that co-pending application since the referenced co-pending application and the instant application are claiming common subject matter.

Applicants respectfully traverse this rejection. However, to reduce the cost and time required to obtain patent protection, a Terminal Disclaimers filed in compliance with 37 C.F.R. 1.321 are attached hereto. The Terminal Disclaimer is offered in the event the Examiner converts the provisional rejection to a rejection based on non-statutory double patenting grounds. The ‘599 application and the instant patent application are commonly owned by ArthroCare Corporation. Applicants previously filed a Terminal Disclaimer for the ‘599 application however due to a clerical error the filing date was incorrect. Applicants enclose a corrected Terminal Disclaimer for the ‘599 application with the correct filing date.

Information Disclosure Statement

Applicants enclose an Information Disclosure Statement and PTO Form 1449, for the Examiner’s review and consideration.

CONCLUSION

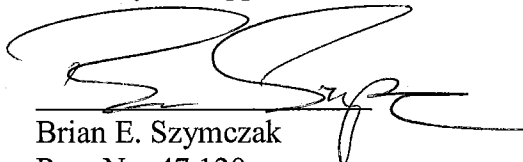
Applicants have made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicants respectfully request reconsideration of the pending claims.

Applicants previously paid for the Terminal Disclaimer filed herewith, and therefore believe no further fee is due.

Applicants hereby authorized the Commissioner to charge \$ 790 for the RCE to Deposit Account No. 50-0359 of ArthroCare Corporation. Applicants believe there are no further fees due at this time, however, the Commissioner is hereby authorized to charge any additional fees necessary or credit any overpayment to Deposit Account No. 50-0359 of ArthroCare Corporation in order to effectuate this filing.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.391.3961.

Respectfully submitted
Attorney for Applicants,



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Date: 6-14-2007

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- Enclosures:
- 1) Information Disclosure Statement and PTO Form 1449
 - 2) A corrected Terminal Disclaimer for the '599 application with the correct filing date.
 - 3) 28 Sheets of Replacement Drawings
 - 4) Application Data Sheet
 - 5) Request for Continued Examination